

[counsel listed on signature page]

UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA  
SAN FRANCISCO DIVISION

ORACLE AMERICA, INC.

Plaintiff,

v.

GOOGLE INC.

Defendant.

Case No. CV 10-03561 WHA (DMR)

**SUPPLEMENTAL JOINT  
PRETRIAL CONFERENCE  
STATEMENT**

Date: December 21, 2011

Time: 8:00 a.m.

Dept.: Courtroom 9, 19th Floor

Judge: Honorable William H. Alsup

Pursuant to the Court's November 21, 2011 order, Oracle America, Inc. and Google Inc. hereby jointly submit (1) a list of four pending motions in limine that the parties believe are most deserving of oral argument; (2) an update on the PTO's progress in reexamining the 26 asserted patent claims; (3) an update on the status of Google's petition to the Federal Circuit for a writ of mandamus regarding the Lindholm e-mail; and (4) a summary of other items that may impact the trial date, duration, and scheduling.

## **I. MOTIONS IN LIMINE FOR ORAL ARGUMENT**

The parties propose that the Court hear oral argument on at least the following four motions in limine at the pretrial conference:

(1) Oracle's Motion in Limine No. 1 to Exclude Evidence or Argument Regarding Patent Reexaminations.

(2) Oracle's Motion in Limine No. 4 to Exclude Evidence or Argument Regarding Oracle's Past Actions with Application Programming Interfaces.

(3) Google's Motion in Limine No. 1 to Exclude Lindholm E-mail and Drafts Thereof.

(4) Google's Motion in Limine No. 3 to Exclude Portions of Cockburn Report on Damages.

## **II. STATUS OF THE REEXAMINATIONS**

### ***Oracle's Statement***

Oracle provides the following update regarding the reexamination status of the six patents-in-suit:

- '520 patent: The PTO has confirmed the patentability of the asserted claims of the '520 patent. A reexamination certificate issued on November 9, 2011.
- '720 patent: On November 18, 2011, the PTO issued an Action Closing Prosecution rejecting the asserted claims of the '720 patent in light of the proffered prior art. Oracle's response seeking reconsideration of this action is due on December 19, 2011.
- '104 patent: The PTO has not yet issued a first office action with respect to the '104 patent.

- '476, '702, '205 patents: The PTO has tentatively rejected the asserted claims of these patents. All responses to the PTO's tentative rejections have been submitted and further office actions are anticipated.

The table below shows the history of the reexaminations for each of the six asserted patents:

Patent No. (type of reexam)	Office Action Issued	Oracle Response Filed	Google Response Filed	Final Office Action Issued	Further Oracle Response Due	Asserted Claims Subject To Reexam	Status
6,061,520 (ex parte)	6/23/11	8/23/11	n/a	n/a	n/a	All (1, 8, 12, 20)	<b>Claims Confirmed Patentable</b>
7,426,720 (inter partes)	5/5/11	7/5/11	8/4/11	11/18/11	12/19/11	All (1, 6, 10, 19, 21, 22)	<b>Claims Rejected</b> Further response from Oracle due on 12/19/11
RE38,104 (ex parte)	pending					All (11, 27, 29, 39, 40, 41)	Awaiting PTO office action
6,192,476 (ex parte)	6/16/11	9/16/11	n/a			All (14)	<b>Claim Preliminarily Rejected</b> Awaiting further PTO office action
5,966,702 (ex parte)	6/6/11	9/6/11	n/a			All (1, 6, 7, 12, 13, 15, 16)	<b>Claims Preliminarily Rejected</b> Awaiting further PTO office action
6,910,205 (inter partes)	8/19/11	10/18/11	11/18/11			All (1, 2)	<b>Claims Preliminarily Rejected</b> Awaiting further PTO office action

### *Google's Statement*

The reexaminations of five of the six patents-in-suit remain ongoing, with roughly two-thirds of the currently asserted claims having been rejected. Eighty percent of the asserted claims as to which the PTO has issued an office action currently stand rejected. In the *inter partes* reexamination of U.S. Patent No. 7,426,720, the PTO has issued an Action Closing Prosecution after rejecting all asserted claims of the patent for a second time. In summary, as shown below, the PTO has rejected all of the asserted claims of four of the six patents; the PTO has not yet issued an office action with respect to one of the six patents; and the PTO has confirmed the patentability of the asserted claims of one of the six patents.

The table below shows the current status of the reexaminations as to the asserted patents:

Patent No. (reexam type)	Reexam Filed	Reexam Ordered	First Office Action Issued	Oracle Respo nse Due / Filed	Google Response Due / Filed	Asserted Claims Subject to Reexam	Asserted Claims Currently Rejected	Asserted Claims Currently Allowed
6,192,476 (ex parte)	3/1	3/23 Control No. 90/011,521	6/16	Filed 9/16	n/a	<b>All</b> (14)	<b>All</b> (14)	None
5,966,702 (ex parte)	2/15	3/23 Control No. 90/011,492	6/6	Filed 9/6	n/a	<b>All</b> (1, 6, 7, 12, 13, 15, 16)	<b>All</b> (1, 6, 7, 12, 13, 15, 16)	None
7,426,720 (inter partes)	3/-1	4/18 Control No. 95/001,560	5/5	Filed 7/5	Filed 8/4	<b>All</b> (1, 6, 10, 19, 21, 22)	<b>All</b> (1, 6, 10, 19, 21, 22)	None; Action Closing Prosecuti on issued 11/18
RE38,104 (ex parte)	2/15	3/28 Control No. 90/011,490	Pending		n/a	<b>All</b> (11, 27, 29, 39, 40, 41)		None
6,910,205 (inter partes)	2/17	4/14 Control No. 95/001,548	8/19	Filed 10/19	Filed 11/18	<b>All</b> (1, 2)	<b>All</b> (1, 2)	None
6,061,520 (ex parte)	2/15	3/23 Control No. 90/011,489	6/23	Filed 8/23	n/a	<b>All</b> (1, 8, 12, 20)		<b>All</b> (1, 8, 12, 20)

### III. STATUS OF GOOGLE'S PETITION FOR A WRIT OF MANDAMUS

With the filing of Google's reply brief on December 5, 2011, the petition is now fully briefed and the parties await further action by the Federal Circuit. Recently, the Federal Circuit has ruled on writ petitions within two to five months of the date briefing was completed. For example:

- *In re Link-A-Media Devices Corp.*, --- F.3d ----, 2011 WL 6004566, Misc. No. 990 (Fed. Cir. Dec. 2, 2011). The petition was fully briefed on July 22, 2011. The Federal Circuit granted the petition on December 2, 2011.
- *In re Shared Memory Graphics LLC*, 659 F.3d 1336 (Fed. Cir. 2011). The petition was fully briefed on May 2, 2011. The Federal Circuit granted the petition on September 22, 2011.
- *In re Vertical Computer Systems, Inc.*, 435 Fed. Appx. 950 (Fed. Cir. 2011). The

petition was fully briefed on June 8, 2011. The Federal Circuit denied the petition in a written opinion dated August 17, 2011.

- *In re Chicco USA, Inc.*, 429 Fed.Appx. 993 (Fed. Cir. 2011). The petition was fully briefed on April 11, 2011. The Federal Circuit denied the petition in a written opinion dated 7/12/2011).

#### IV. TRIAL SCHEDULING CONSIDERATIONS

**Oracle's Statement:** To avoid further delay, Oracle requests that the Court set a trial date as early as possible following the submission of Dr. Kearl's expert report on January 19, 2012. For the Court's information, the parties have listed below the trial commitments of lead counsel in early 2012. Nonetheless, the parties can be expected to accommodate whatever date is convenient for the Court.

**Google's Statement:** Google agrees that the trial should begin as soon as possible following the submission of Dr. Kearl's expert report on January 19, 2012. In light of the prior commitments of lead counsel for both parties, however, and in light of the Court's announced plan to trifurcate the trial with jury deliberations following each phase, Google proposes that early July 2012 is the earliest practicable date for trial.

#### Lead Counsel Trial Commitments

The parties have conferred regarding the schedules of lead trial counsel Michael Jacobs and David Boies for Oracle, and Robert Van Nest and Christa Anderson for Google. Messrs. Jacobs, Boies, and Van Nest, and Ms. Anderson have certain prior commitments in the first few months of 2012 that could conflict with the trial date in this case. Those trial commitments are as follows:

##### Michael Jacobs

- *eTool Development, Inc. et al v. National Semiconductor Corporation*, EDTX Case No. 2:08-cv-00196-WCB. Pretrial conference December 20, 2011; trial January 3-10, 2012.
- *In the Matter of Certain Electronic Digital Media Devices and Components Thereof*, Investigation No. 337-TA-796 (U.S. ITC). Trial May 31-June 6, 2012.

##### David Boies

- *Rincon EV Realty LLC, Rincon ET Realty LLC, and Rincon Residential Towers LLC v. CP III Rincon Towers, Inc., and DOES 1 through 50, inclusive*, San

1 Francisco Superior Court Case No. CGC-10-496887. Trial date is currently  
2 February 27, 2012 (expected 2-3 weeks).

3 **Robert Van Nest**

- 4 • *New York v. Intel Corp.*, D. Del. No. 09-827 (LDS). Pretrial Conference Jan. 27,  
5 2012; trial February 14-24, 2012.
- 6 • *Commonwealth Scientific and Industrial Research Organization v. Lenovo (United*  
7 *States) Inc.*, E.D. Tex. No. 6:09-cv-399 (LED). Pretrial Conference March 22,  
8 2012; trial April 2-20, 2012.
- 9 • *Genentech Inc. v. Trustees of the University of Pennsylvania*, N.D. Cal. No. 5:10-  
cv-02037 LHK (PSG). Pretrial Conference May 23, 2012; trial June 11-22, 2012.
- 10 • Mr. Van Nest also plans to be out of the country from April 26-May 11, 2012.

11 **Christa Anderson**

- 12 • *Marin Health Care District v. Sutter Health*, JAMS Ref. No. 1100065277.  
Arbitration Jan. 17-Feb. 10, 2012.
- 13 • *Commonwealth Scientific and Industrial Research Organization v. Lenovo (United*  
14 *States) Inc.*, E.D. Tex. No. 6:09-cv-399 (LED). Pretrial Conference March 22,  
15 2012; trial April 2-20, 2012.
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1 Dated: December 7, 2011

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**ATTESTATION**

I, Michael A. Jacobs, am the ECF User whose ID and password are being used to file this  
SUPPLEMENTAL JOINT PRETRIAL CONFERENCE STATEMENT. In compliance with  
General Order 45, X.B., I hereby attest that Robert A. Van Nest has concurred in this filing.

Date: December 7, 2011

/s/ Michael A. Jacobs